

B+D1
29. (New) The operation and display section of claim 11, wherein the copy key, the copy server key, and the printer key are arranged in a vertical array.

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 11 and 26-29 are presently active. Claims 26-29 have been added by the present amendment. The additions to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,880,851 to Imada (hereinafter "the '851 patent") in view of U.S. Patent No. 5,812,900 to Hashimoto et al. (hereinafter "the '900 patent"), U.S. Patent No. 4,619,514 to Ide (hereinafter "the '514 patent"), U.S. Patent No. 4,448,515 to Ishikawa (hereinafter "the '515 patent"), and U.S. Patent No. 6,353,482 to Abe et al. (hereinafter "the '482 patent").

Claim 11 is directed to an operation and display section of an operation unit for an image forming apparatus comprising, *inter alia*: (1) a touch screen panel substantially centered on the operation unit; (2) numeral keys and an enter key located on the right-hand side of the touch screen panel; (3) a clear/stop key located on a right-hand side of the numeral keys and the enter key; (4) a start key located to a right-hand side of the clear/stop key and having a larger diameter than the numeral keys; and (5) a set/counter key located on the top left-hand side of the touch screen panel. Note that Claim 11 recites other keys not specifically listed above.

Regarding the rejection of Claim 11 under 35 U.S.C. § 103, the Office Action asserts that the '851 patent discloses everything in the claims with the exception of an enter key, a program key, a reset/preheat key, a set key, a trial copy key, a copy key, a copy server key, a printer key, and the relative positions of the keys to each other, and relies on the '900, '514, '515, and '482 patents to remedy the deficiencies. In particular, the Office Action asserts that the '514 patent discloses a set key and that it would have been obvious to combine the '514 set key with the '851 counter key to obtain the claimed set/counter key.

The '851 patent is directed to an image processing apparatus having a counter key 62 located on the left side of a keyboard/display device 3.¹ However, as admitted in the Office Action, the '851 patent fails to disclose the claimed set/counter key. Moreover, Applicants note that the '851 patent fails to disclose a set key.

The '514 patent is directed to a monochromatic photocopying apparatus that includes an operation panel 71 having “a copy key 72, a set key 73 for setting the quantity of the copies to be duplicated, and a clear/stop key 74 for clearing the preset copy quantity.”² However, as shown in Figure 2 of the '514 patent, the “set key 73” actually consists of *ten separate numerical keys*. Accordingly, Applicant respectfully submits that the set key 73 disclosed by the '514 patent is, in actuality, a numeric keypad for entering the number of copies to be printed.³ Further, Applicant notes that Claim 11 recites both a set/counter key on the left-hand side of a touch screen and numeral keys on the right-hand side of the touch screen.

¹'851 patent, Figure 3.

²'514 patent, column 4, lines 49-52.

³Note that, as is customary in the art, the clear stop key 74 is located directly adjacent to the ten set keys of the '514 patent.

Thus, no matter how the teachings of the '851 and '514 patents are combined, the combination does not teach or suggest the claimed set/counter key located to a top left-hand side of the touch screen panel. Accordingly, Applicant respectfully submits that a *prima facie* case of obviousness has not been established and that the rejection of Claim 11 should be withdrawn.

In addition, Applicant notes that the stated motivation for combining the '851 counter key with the '514 "set key" is because "they perform related functionalities and in order to reduce the cluttering of the operational panel's area." However, Applicant respectfully submits that the Office Action has failed to indicate how the functionalities of the '851 counter key and the '514 set keys are related. In addition, it is unclear to Applicant how combining the '851 counter key with the '514 set keys would "reduce the cluttering of the operational panel's area." Finally, Applicant respectfully submits that there would be no technological motivation to combine any of the '514 set keys with the '851 counter key since it is unclear how such a combination would operate.⁴ Accordingly, for these additional reasons, Applicant respectfully submits that a *prima facie* case of obviousness has not been established and that the rejection of Claim 11 should be withdrawn.

The present amendment also sets forth new Claims 26-29 for examination on the merits. Claims 26-29, which depend from Claim 11, recite additional limitations of the operation display section of Claim 11. New Claims 26-29 are supported by the originally filed specification and do not add new matter.⁵ Moreover, based on the asserted allowability

⁴Moreover, it is unclear to Applicants why one of ordinary skill in the art would have been motivated to combine (for example) *only one* of the '514 set keys with the '851 counter key.

⁵See pages 6 and 7 of the specification.

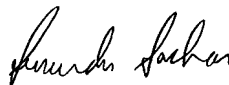
of Claim 11, Applicant respectfully submits that dependent Claims 26-29 patentably define over the '851, '900, '514, '515, and '482 patents.

Thus, it is respectfully submitted that independent Claim 11 (and dependent Claims 26-29) patentably define over the cited references.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599
Surinder Sachar
Registration No. 34,423



22850

Tel.: (703) 413-3000
Fax: (703) 413-2220
GJM:SNS:KMB:sy
I:\atty\kmb\05574557-am.wpd

0557-4557-2



Marked-Up Copy

Serial No: 09/219,890

Amendment Filed on:

4-2-3

IN THE CLAIMS

Claims 26-29 (New).